

## STATEMENT OF CLAIMS STATUS

Claims 1-10 are pending in the application.

Claims 1-10 stand rejected.

## SUMMARY OF OFFICE ACTION

### Information Disclosure Statement

1. The Examiner states that the information disclosure statement filed 6-3-98 fails to comply with 37 CFR 1.97(c) because it lacks a statement as specified in 37 CFR 1.97(e), and that it has been placed in the application file, but the information referred to therein has not been considered.
2. The Examiner further states that the information disclosure statement filed 8-3-98 fails to comply with 37 CFR 1.97(c) because it lacks the fee set forth in 37 CFR 1.17(p), and that it has been placed in the application file, but the information referred to therein has not been considered.

### Election/Restriction

3. The Examiner states that claims 11-13 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected invention and that election was made without traverse in Paper No. 7.

### Claims Rejections - 35 USC § 112

4. The Examiner states that claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a credible asserted utility or a well established utility. The Examiner states that the claims are directed to a method of exterminating

insects by directing a killing solution comprising an aqueous formulation containing capsicum into infested areas of the structure and contacting the insects, and that the well established utility of using capsicum in treating an ingested area is that the capsicum repels insects and creates a synergistic affect when used with an existing insecticide. The Examiner cites the patent to Hainrihar, '597, column 1, lines 39-47, and states that the prior art has established that the use of capsaicinoids, which encompasses capsicum, is nontoxic to insects, and that Applicant's claim that their invention of exterminating/killing insects with an aqueous solution containing capsicum is not credible unless the applicant can supply some form of unbiased scientific evidence which disputes the assertion set out in the prior art. The Examiner also states that claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, since the claimed invention is not supported by either a credible asserted utility or a well established utility for the reasons set forth above, and that one skilled in the art clearly would not know how to use the claimed invention.

#### **Response to Amendment**

5. The Examiner states that the declaration under 37 CFR 1.132 filed 8-3-98 is insufficient to overcome the rejection of claims 1-10 based upon the 101 and 112 rejections as set forth in the last Office action because the declaration is merely an opinion by the applicant that capsicum in his solution kills termites, and that the Applicant states that they experimented with one or two or three different types of insects and the effects of their insecticide on them, and that the experiments are merely done once or twice on the certain insect and conclude that it kills the insect, and that in order for the results of these experiments to have any credibility, a statistical analysis needs to be done to determine how many of these experiments must be performed on a specific insect to determine factually that the solution

is actually killing the insect, and that one or two experiments is not enough evidence to sway the Examiner's opinion that the capsicum is non-toxic to insects, and that a third party should perform these experiments in order for their results to be considered credible and unbiased, and that the third party should be an accredited lab or person to give credibility to the results.

6. The Examiner states that the Applicant's arguments filed 8-3-98 have been fully considered but that they are not persuasive.

#### Final Action

7. The Examiner states that the Action is made final, and that the Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

#### AMENDMENTS

Please amend the claims as follows:

1. Claim 1 (once amended) A method for exterminating [insects from structures] subterranean termites consisting of directing a killing solution comprising an aqueous formulation containing capsicum [into infested areas of the structure,] and directly contacting <sup>no ant</sup> the insects which comprise the <sup>no ant.</sup> infestation [directly] with the killing solution for a period of 24 hours. <sub>✓</sub> <sup>no ant. neper</sup>

#### RESPONSE

#### Response to 35 U.S.C. § 101 Rejection

Applicant hereby respectfully requests that Hainrihar be withdrawn as a contrary or contradictory teaching under 35 U.S.C. § 101.

### **Declaration of Jeffrey Y. Honda, Ph.D.**

Filed concurrently herewith and incorporated herein in its entirety, please find the Declaration of Jeffrey Y. Honda, Ph.D. in support of the Application. Dr Honda is an Assistant Professor at San Jose State University in the Department of Biological Sciences. He holds a Ph.D. degree in the field of Entomology and has over ten years of professional experience. He has taught and done research at numerous nationally and internationally accredited institutions of higher learning. He has received recognition for my academic achievements both here in the United States as well as internationally.

As per his declaration, Dr. Honda has concluded that "Habanero" pepper extract has the ability to kill subterranean termites under the following controlled laboratory conditions: direct contact with the pepper extract and continuous exposure to this extract for 24 hrs in a contained environment. Dr. Honda's conclusion is in direct contradistinction to the teachings of Hainrihar, '597.

(Applicant is unable to address the basis of the assertion in the Hainrihar patent that "capsaicinoids are not toxic to insects" because, admittedly, Applicant has not reviewed the prosecution file nor the personal files of M. Hainrihar. Nevertheless, Applicant does not interpret the teachings of Hainrihar to be the results of scientific study or observation.)

### **CONCLUSION**

Applicants submit that all claims, as presented and as amended herein, describe useful, novel and non-obvious patentable subject matter. Applicants further submit that all claims as presented and amended herein are presently allowable and respectfully request that Examiner allow the application to issue.

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Respectfully submitted,



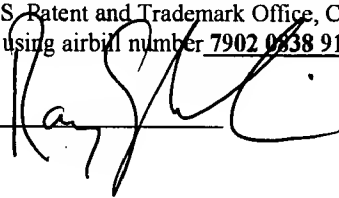
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**CERTIFICATE OF DELIVERY WITH FEDERAL EXPRESS SERVICE**

I hereby certify that this paper and the documents referred to as attached therein are being deposited with the Federal Express delivery service using overnight service, under 37 CFR 1.08, on the date indicated above and is addressed to "Jack Lavinder, Examiner, U.S. Patent and Trademark Office, Crystal Mall 1, Re-Eng. Lab., 1911 S. Clark Place, Suite 600, Arlington, VA 22202-3513" using airbill number 7902 0838 9165.

Signed: \_\_\_\_\_



Date Mailed: February 22, 1999